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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,732	08/04/2003	Eugenio G. Mannella	5810-03/B &D0002.US	5574
7590	09/15/2004		EXAMINER	
Ronald, K. Aust Taylor & Aust, P.C. 12029 E. Washington Street Indianapolis, IN 46229			ESTREMSKY, GARY WAYNE	
			ART UNIT	PAPER NUMBER
			3676	

DATE MAILED: 09/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/633,732	MANNELLA, EUGENIO G.
	Examiner	Art Unit
	Gary Estremsky	3676

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 18 June 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-19 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 04 August 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/4/03</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-9, 12-14, and 16-19 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 1,887,655 to Marple.

Marple '655 teaches Applicant's claim limitations including : a "liner body" - 14, a "handle assembly having an insert member" - 15, a "bore" - 12, "perimetrical groove" - 18, a "retaining ring" - 17, a "spindle assembly" - including 8, "including a stop member" - the portion of the spindle received inside of the handle as shown in Fig 1, a "ramp" - bevel at 22, "stop surface" - either edge of groove 18 abutting 20 reads on limitation.

Much of the functional recitations carry little patentable weight since they do not define any particular structure. See MPEP 2114. While it is not currently considered to be at issue, please note MPEP 2173.05(p) section II as regards *product and process of using* in a single claim. Present functional limitations are interpreted essentially as describing a *capability* of the structure that is positively recited as the invention but it has been held that the recitation that an element is

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"capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense.

In re Hutchison, 69 USPQ 138. Claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974).

As regards claim 5, part 9 reads on "limit member".

As regards claim 6, parts 4,5 read on limitation of "lock mechanism" inasmuch as the spindle is secured or locked thereto and the limitations defining that element don't include any structure that might be relied upon to patentably define from the well known structure of the prior art. Parts 4 and 5 both include a shaft opening as shown in Fig's 1,2 and define a "notch" therebetween as shown in fig 1 which is inherently capable "to facilitate passing said stop member of said spindle (end portion) through said lock mechanism as said spindle shaft is received in said shaft opening". The law of anticipation requires that a distinction be made between the invention described or taught and the invention claimed. It does not require that the reference "teach" what the subject patent teaches.

Assuming that a reference is properly "prior art," it is only necessary that the claims under consideration "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or "fully met" by it. *Kalman v. Kimberly-Clark Corp.*, 218 USPQ 789.

As regards claim 7, part 9 reads on "limit member".

As regards claims 17-19, one of ordinary skill in the art would recognize the broadly-recited steps of assembly of the structures delineated above are

inherently taught by the full description and illustration of the invention of Marple '655.

2. Claims 9-14 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 1,862,716 to Solliday.

Solliday '716 teaches Applicant's claim limitations including : "spindle shaft" - including 13,15, a "lock mechanism" - including 2,3,4,7,8,9, a "stop member" - 19, "including a ramped surface" as shown, and a "stop surface" - 22.

As regards claim 12, Solliday '716 teaches "limit member" - 14.a "lock mechanism" - including 2,3,4,7,8,9, a "stop member" - 19, "including a ramped surface" as shown, and a "stop surface" - 22.

As regards claim 12, Solliday '716 teaches "limit member" - 14.

3. Claims 9-11 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 4,672,829 to Gater.

Gater '829 teaches Applicant's claim limitations including : "spindle shaft" - 80, a "lock mechanism" - including 102, a "stop member" - end of 82, "including a ramped surface" - the angled surface of 82 as shown in Fig 13, and a "stop surface" - end surface of 82 shown to be in abutment in Fig 13.

Response to Arguments

4. Applicant's arguments have been fully considered but are not fully persuasive.

Careful reference to Fig's 1 and 3 of the Marple '655 reference indicate that the "insert member" (15) has a groove about its perimeter at 18 wherein resides a "retaining ring" (17). Part 15 is further cut back in the region of part 10 as shown in Fig 3 whereby the "perimetrical groove" (18) extends to the center "bore" (12) of the "insert member" (15). The reference discloses a 'member' (15) that is' inserted', and has all of the structure recited in the claim corresponding to same. Perhaps arguments related to the "insert member" of Marple '655 are premised on some misunderstanding of the structure of the reference, then examiner might assume that further argument that Marple '655 does not teach a "spindle assembly including a spindle shaft" and "retaining ring" rely on that same (mis)understanding of the prior art since the prior art's disclosure of these further elements as discussed in the above grounds of rejection seems clear.

Argument that 'installing' does not anticipate "mounting", etc. is not persuasive when the reference plainly shows the element in its mounted configuration.

The measure for patentability is not whether the prior art can be described using different terminology but whether or not the claims being examined can reasonably read on the prior art. Applicant's conclusion that structures of Marple '655 are not readable on the claimed elements are not persuasive.

As regards rejections in view of Solliday '716 and Gater '829, Applicant's arguments are similar to above and amount to little more than a conclusion that the claims are patentable since the claims' elements are not the same as the prior art elements.

At issue is whether the claims are interpreted properly. It is the examiner's position that it is well settled that claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974). The law of anticipation requires that a distinction be made between the invention described or taught and the invention claimed. It does not require that the reference "teach" what the subject patent teaches. Assuming that a reference is properly "prior art," it is only necessary that the claims under consideration "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or "fully met" by it. *Kalman v. Kimberly-Clark Corp.*, 218 USPQ 789.

Otherwise, it is important to note that connection of two parts does not require direct contact. For example, despite the fact that the tires of a car are in contact with wheels (and not the hubs), and that the wheels are in contact with hubs (and not the spindles), and that the hubs are in contact with spindles (but not the frame or body panels of a car), etc., most people would agree that the tires are *connected to* the car. Plain meaning of the term does not require direct contact and courts have agreed that limitation of 'connected to' is broad enough to encompass connection via intermediate members. But furthermore, it should be noted that limitation of "configured for connection" is broader yet, since it *does not positively recite any connection* and thereby it does not require that an anticipatory reference disclose a connection, only that it has some sort of structure that is *capable of* being connected. It has been held that the recitation that an element is "capable of" performing a function is not a positive limitation

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but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Additionally regarding claim interpretation, it should be noted that recitation of "lock mechanism" does not define *any specific structure* and at most, requires an anticipatory reference to teach some generic structure at least associated with latching or locking, since it is accepted in the art as a matter of fact that the term 'lock' and 'latch' have a long history of being used interchangeably (despite Examiner's personal preference that there was a more exact meaning) whereby broad interpretation is required and is appropriate. The limitation cannot be given weight in accordance with 35 USC 112, 6th paragraph. See MPEP 2181-2185.

That said, it is the examiner's belief that a proper grounds of rejection has been made and should not be withdrawn.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will

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the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Estremsky whose telephone number is 703 308-0494. The examiner can normally be reached on M-Thur 7:30-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Will can be reached on 703 308-3870. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gary Estremsky
Primary Examiner
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